

REMARKS

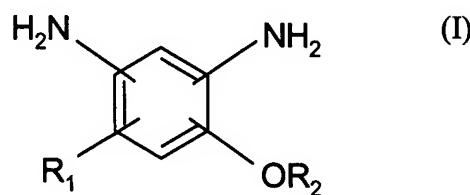
Reconsideration of the present application is respectfully requested.

In this paper, newly presented claim 10 replaces canceled claim 7, and includes all limitations of withdrawn claim 1 and claim 7. It is therefore requested that the objection under 37 C.F. R. § 1.75 (c) be withdrawn.

Claims 7-9 were rejected under 35 U.S.C. § 102 (b) as anticipated by the teachings of U.S. Patent no. 5,276,132, Nishikawa, et al. The examiner contends that Nishikawa, et al. teaches liquid crystal aligning agents containing a polymer selected from the group consisting of polyamic acid having a steroidal skeleton.

Nishikawa et al. specifically discloses three preferred classes of polymers, characterizable by their general chemical formula, disclosed in cols 2-3 of Nishikawa et al. While the examiner takes the position that the present invention is anticipated by Nishikawa's teachings, it is noted that the specifics supporting that conclusion are not provided. It is observed that the office action does not indicate from which of these three formulae a person of skill in the art would use to arrive at the conclusion that Nishikawa et al's teachings anticipate the invention claimed herein. Since Nishikawa et al. discloses literally hundreds, if not thousand of polymers that the reference purports function as liquid crystal aligning agents, it is requested that in the event the examiner maintain the rejection, that specific passages of the reference relied upon to support such conclusion. It is noteworthy that while claim 9 of the present application is directed to a chemical species, no indication of where the anticipatory teaching concerning this claim has been provided, aside from general reference to six columns of patent text.

In any event, the applicants have studied Nishikawa et al., and as understood by the applicants Nishikawa et al's teachings should not bar the patenting of the presently claimed invention. The polyimide resins for use in a liquid crystal display, as recited in claim 10 presented herein, are the result of the polymerization of a tetracarboxylic acid (or dianhydride derivative thereof) with a diamine, wherein the diamine comprises at least 5 mol % of one or more of the diamine derivatives of formula (I), which is reproduced below:



Formula I (of the present application) represents a benzene diamine radical to which, among other things, a cholesterol group is attached to the benzene diamine radical by an oxo-linkage¹. In contrast, the diamine of formulas II and III of Nishikawa et al. do not teach that a cholesterol radical is joined to the benzene diamine by an oxo-group linkage. Formula II of Nishikawa et al. requires that R² be a trivalent or tetravalent organic group. There appears to be no disclosure in Nishikawa et al. where R₂ is the particular benzyl radical required to disclose the aromatic diamine recited in the present claims. In fact, it appears that the specification fails to define R₂ with any particularity beyond describing it as a trivalent or tetravalent organic group. Further disclosure is provided in claim 1 of the Nishikawa et al., where the formula II is shown as H₂N- R²-NH₂, a diamine structure, with R² then described as a “diamine”, which would appear to lead a person of ordinary skill in the art to conclude that what results is a quaternary amine structure.

As for specific polymer III, (see col. 2, line 63, col. 3, line 15) requires a cholesterol linkage on the monoamine (formula IV) that joins to the diamine, which appears to eliminate the possibility of an oxo linkage between the ring structure and cholesterol moiety.

To the extent we have understood the examiner’s position, we believe there are significant differences between the teachings of Nishikawa, et al. and the invention as claimed, as indicated above. Despite the breadth of Nishikawa et al.’s teachings, there appears to be nothing in Nishikawa et al. that would lead a person of skill in the art to select the substituents necessary to arrive at the claimed compounds. Under U.S. Patent Law, it is not enough that a compound is encompassed within a disclosed formula – there must be motivation or suggestion to produce that compound. In other words, that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. In re Jones, 958 F.2d 347, 350 (Fed. Cir. 1992). The prior art reference must provide a motivation to make the proper selection to arrive at the claimed compound or compounds. See In re Baird, 16 F.3d 380 (Fed. Cir. 1994), where the court indicated:

“While the Knapp [reference] formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp [reference] suggesting that one should select such variables. . . . Given

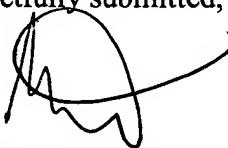
¹ See claim 10: “R₂ is a cholesterol derived radical selected from the group consisting of...”

the vast number of diphenols encompassed by the generic diphenol formula in Knapp, and the fact that the diphenols that Knapp specifically discloses to be ‘typical’, ‘preferred’, and ‘optimum’ are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A. See *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993).....A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.”

It is the applicants view that the extremely broad disclosure of Nishikawa’s teachings, which does not provide the motivation to arrive at the polyimide resin compounds claimed by the applicants in fact mitigates in favor of patentability of the invention as claimed.

Wherefore, based upon the foregoing, it is submitted that the present application is in condition of allowance and a relatively early reply is respectfully requested.

Respectfully submitted,



Richard J. Danyko
Registration No. 33,672

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
516-742-4343
RJD:ej